APPENDIX A.

Decision of the Board of Patent Interferences.

Final Hearing
October 7, 1955

Paper No. 62
PIH/lmh

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF PATENT INTERFERENCES

U. S. PATENT OFFICE
JAN 25 1957
MAILED

Patent Interference No. 86,436

Wagner and Strother *v.* MacKenzie, Spialter and Schoffman

Process of Producing Organosilicon Compounds

Patent granted George H. Wagner and Corneille O. Strother March 17, 1953, No. 2,632,013, on application filed October 9, 1946, No. 702,084

Application of Charles A. MacKenzie, Leonard Spialter and Milton Schoffman filed June 27, 1946, No. 679,856

Mr. DONALD C. HARRISON, Mr. F. DONALD BROOKER, Mr. ROBERT H. DUNLAP, Messrs. WATSON, LEAVENWORTH and KENTON, Mr. RUDOLPH S. NELSON and Mr. LOUIS C. SMITH, JR. for Wagner and Strother

Messrs. EYRE, MANN and BURROWS and Mr. SOL SHAPIRIO for MACKENZIE, SPIALTER and SCHOFFMAN

The invention herein involved pertains to a process for the production of organosilicon compounds by reacting an alkyne (typified by acetylene, $HC \equiv CH$) with selected silanes at constant volume (i.e., pressure bomb) at a temperature not substantially above 350° C. The count is as follows:

> A process for the production of organosilicon compounds which comprises reacting an alkyne with a silane of the group consisting of halogenosilanes and alkoxysilanes having at least one Si—H bond while heating the reactants at substantially constant volume and at a temperature not substantially above 350° C.

MacKenzie, Spialter and Schoffman, the senior party, hereinafter termed MSS, filed their involved application Serial No. 679,856 on June 27, 1946. Wagner and Strother, the junior party, hereinafter termed W and S, are involved on claim 2 of Patent No. 2,632,013 issued March 17, 1953 on application Serial No. 702,084 filed October 9, 1946 and have the burden of proof by a preponderance of the evidence. The MSS application is assigned to the Ellis-Foster Co. and the patent of W and S to the Union Carbide and Carbon Corporation.

Only W and S took testimony, but both parties filed preliminary statements and briefs and argued orally at the final hearing. In addition to priority based on the testimony there are presented questions of right to make and estoppel by both parties based on duly filed motions.

The nature of some of the questions raised dispenses with consideration of the testimony and indicates the desirability of a degree of precedence in their consideration. If the ground of estoppel urged by MSS and against W and S is valid then it is error to consider the priority evidence. Steinmayer *v.* Ramsey 30 CCPA 802, 1943 C.D. 213, 551 O.G. 557, 132 F. 2d 1007. Also if, as urged by W and S, MSS have no support for the count then the said ground of estoppel against W and S dissipates and it would be unnecessary to consider the W and S testi-

mony since W and S would prevail. Also a study of the record shows that if MSS have support for the count W & S are estopped in which event it is again error to consider the W and S testimony. First however the question of readability of the count on the W and S disclosure will receive disposition, then that of support by MSS.

The attack by MSS relating to support for the count in the W and S disclosure is for the most part legally defective. They except for a few items admit the count reads on specific example 9 of W and S, but urge W and S has insufficient breadth of disclosure as to alkynes, halogenosilanes, alkoxysilanes and range of temperature not substantially above 350°C. Such contentions relate to patentability or validity, but are not ancillary to priority and cannot be considered here. Blodgett and Hanson *v.* Richter 23 CCPA 749, 1936 C.D. 99, 27 USPQ 398; Walsh et al. *v.* Davidson et al. 26 CCPA 812, 1939 C.D. 203, 40 USPQ 376; Kyrides *v.* Andersen et al. 28 CCPA 1336, 1941 C.D. 720, 50 USPQ 131.

Otherwise MSS contend that W and S do not disclose conducting the reaction at constant volume, even in Example 9, nor whether pressure was maintained during the "3 hours" reaction, and in Example 9 discloses the use of a catalyst not specified in the count. The latter two contentions assume fictional requirements in the count. There is no limitation in the count requiring the maintenance of pressure throughout the reaction or requiring the absence of a catalyst. As for the constant volume limitation it is clear there is no permissible alternative interpretation of the procedure and apparatus used in Example 9. In the patentee's introduction to the examples, column 4, it is stated "most of our experimental work was carried out in bombs" and in lines 36 to 51, col. 4, as follows:

> • • • When one of the reactants is a gas, or a liquid readily volatile at the reaction temperature, and the reaction mixture is permitted to expand freely on heating it, the concentration of that reactant will obviously fall to a low value, thus considerably slow-

> ing the reaction rate. If, however, the reactants are charged to a closed vessel which is sealed before heating it, the initial concentration of any reactant can fall off only through its consumption by the reaction. If a reactant is a gas, it may be desirable to charge the reaction vessel to a considerable pressure to secure an adequate concentration and reaction rate, and also to supply enough of the reactant to produce an acceptable quantity of product.

This is a clear teaching that where one of the reactants is a gas it is necessary in order to secure some efficiency in the reaction to charge the gas to a considerable pressure in a closed reaction vessel. In Example 9 the acetylene (alkyne) used is a gas and the example specifies charging it to a 300 cc. Monel metal vessel to an initial pressure of 17 atmospheres. Since 17 atmospheres is a considerable pressure the instruction means to any reasonable chemist that a 300 cc. Monel metal bomb must be used and that is a constant volume reaction container. In fact in Example 2 calling for a similar reaction using ethylene gas instead of acetylene an identical vessel is specified and it is called a "bomb". W and S clearly disclose in Example 9 heating the reactants "at substantially constant volume". It is held that the count is clearly readable on the disclosure of the W and S patent.

The question of support for the count in the MSS application was considered by the Primary Examiner and decided favorably to MSS. The Primary Examiner's decision will be considered on review to the extent that there is raised a question ancillary to priority, namely, whether or not the MSS application sufficiently teaches a disclosure upon which the count is readable.

In relation to this question it seems not to have been appreciated earlier in the proceeding that MSS have more than an ordinary burden of proceeding. Having extracted the claim of an issued patent it is not enough for MSS to show a reasonable or inferential disclosure but they must show a clear prior disclosure in which any doubt is resolved against them. This is stated in Bierly *v.* Ha-

poldt, Jr. (. CCPA , 1953 C.D. 88, 201 F. 2d 955, 96 USPQ 406) as follows:

> It is well settled, of course, that one who extracts claims from an issued patent for the purpose of securing an interference must show clear prior disclosure (Brand *v.* Thomas, 25 CCPA (Patents) 1053, 96 F. (2d) 301, 37 USPQ 505) and in such a case any doubt as to an applicant's right to make the copied claims must be resolved against him. See Jorgenson *v.* Kingsland, Commissioner of Patents, 83 Fed. Supp. 319, 81 USPQ 465, citing Lindley *v.* Shepherd, 58 App. D. C. 31, 24 F. (2d) 606, wherein the Court of Appeals of the District of Columbia (now the U. S. Circuit Court of Appeals, D. C. Circuit), our immediate predecessor in this jurisdiction, after quoting the foregoing statutory language said: * * * Shepherd [from whose patent the claims in issue have been copied by Lindley] complied with this statute. Lindley did not. His amendment [adding the claims to his application] was inspired by knowledge of what Shepherd had accomplished, and all doubts as to his right to appropriate what has been granted Shepherd should be resolved against him. It is not enough that he may have had a conception of the invention he seeks to appropriate. His application must disclose it. Herzog *v.* N. Y. Tel. Co. (C.C.A.) 172 F. 425; Id. (C.C.A.) 176 F. 349; Hestonville *v.* McDuffee (C.C.A.) 185 F. 798.
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> We think doubt as to sufficiency of disclosure should be resolved against one who copies claims for the purpose of interference in all instances, and most emphatically so in cases where the claims are copied from an existing patent.

Confirmation of the doctrine appears in the recent case of Crome *v.* Morrogh 44 CCPA , 1957 C.D. 112 USPQ 49, which adds as follows:

"Furthermore, it is elementary that every express limitation appearing in a claim copied for the purpose of interference must be regarded as material in determining the right to make the count. In re Draeger et al., 32 CCPA 1217, 150 F. 2d 572, 66 USPQ 247, and authorities there cited".

The MSS application was filed with 21 pages of description including thirteen specific examples, and forty-eight original claims. The thirteen examples set forth reactions with a number of specific olefinic or alkene compounds ($\acute{c} = \acute{c}$) but none set forth a reaction with a specific alkyne ($-C \equiv C-$). None of the 48 original claims was directed to a reaction with a specific alkyne. On pages 4 and 5 of the specification there is stated generally that a wide variety of unsaturated organic compounds may be utilized in the reaction such including an ethylenic or acetylenic linkage and this statement is followed by designation specifically and by class of at least hundreds of possible olefinic (ethylenic) type reactants and an incidental mention of acetylene and phenylacetylene. There is a statement on page 7 that generally temperatures above 250°C should be employed but such are dependent on the pressure employed. The count requires a temperature not substantially above 350°C. Acetylenic compounds differ in kind from olefinic compounds because of the additional unsaturated bond and there is no clear teaching that the acetylenic reaction should be governed by the same temperatures of reaction as set forth in the olefinic specific examples. Even so two of the examples (Nos. 4 and 10) specify a temperature range of 350° to 380°C which is distinctly not a clear teaching of "not substantially above 350°C". As to the reaction of the count the MSS specification contributes mostly an invitation to experiment.

The Primary Examiner admitted in his decision that MSS have no specific disclosure of the reaction involving an alkyne but inferred it from the aforesaid recitation of acetylenic compounds among the reagents and the specific disclosure of the reaction of the silanes with other unsaturated hydrocarbons. This would be a permissible type of

inference under other conditions where uncertainties are lacking as per the fundamental doctrine of Guinot *v.* Hull, 40 CCPA 982, 1953 C. D. 296, 97 USPQ 441, that is, where the count is broad as to conditions, the reaction is simple and there is a comprehensive teaching covering all reactants as illustrated in Lawson et al. *v.* Bruce et al., 42 CCPA 893, 1955 C. D. 205, 105 USPQ 440, but not where, as is the case here, those elements are lacking. The inference here is of the type disapproved in Brand *v.* Thomas.

As to the temperature limitation the Primary Examiner took the viewpoint that W and S do not teach it to be critical and the specific examples of MSS teach temperatures within the requirement. Whether or not W and S teach the temperature limitation to be critical is not a relevant question. The relevant question is whether or not MSS teach a material limitation of the count and they do not teach the temperature limitation with respect to an acetylenic reactant. It is noted that, contrary to the Primary Examiner's opinion MSS earlier, as shown on pages 5 and 6 of their brief on ex parte appeal to the Board of Appeals (paper 31), represented that in order to control the products produced in the olefinic reaction there must be:

> "critically controlled conditions of temperature, pressure and time * * *."

This they illustrate by showing that depending on the conditions degradation or synthesis in the products produced is promoted. They state:

> "Consequently control of temperature, and pressure, are of greatest importance in control of the products obtained."

If such control of conditions for the olefinic reaction is necessary it is equally necessary for the alkyne or acetylenic reaction and as to the latter the conditions are not specifically taught. It is held therefore that the MSS application does not support the count.

The grounds of estoppel urged by the parties are in relation to respective failure to move to add the involved

subject matter for interference purposes in two earlier terminated interferences, Nos. 83,787 and 84,821 in which the herein identical applications were involved in the same order with a Barry et al. as senior party. Both interferences terminated in favor of Barry et al. but before this occurred and while MSS were still present and in a position relatively senior to W and S, and W and S filed concessions of priority to Barry et al. Since MSS were in a position senior to W and S it cannot be properly held that there was a clear duty on MSS to propose the involved subject matter and hence they are not barred by motion period estoppel. Contingent on support in the MSS application there was such a duty on W and S as the juniormost party but they after termination of the interferences successfully urged that MSS did not sufficiently teach the involved subject matter. Since it now turns out that W and S were correct in that position it is held that they too are not barred by estoppel.

Under the circumstances W and S stand to prevail and it is not necessary to discuss the testimony. MSS brought various motions including motions to strike in regard to certain portions of the W and S testimony and these likewise require no disposition.

Priority of invention of the subject matter in issue is hereby awarded to George H. Wagner and Corneille O. Strother, the junior party.

BOARD OF PATENT INTERFERENCES

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P. I. Heyman
Examiner of Interferences

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J. Isaacs
Examiner of Interferences

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H. Magil
Examiner of Interferences

APPENDIX B.

Opinion of the District Court Dated December 30, 1959.

UNITED STATES DISTRICT COURT

DISTRICT OF NEW JERSEY

Civil Action No. 217—57

ELLIS-FOSTER COMPANY and MONTCLAIR RESEARCH CORPORATION

Plaintiffs

v.

UNION CARBIDE CORPORATION

Defendant

APPEARANCES:

STEELMAN, LAFFERTY & ROWE By WILLIAM ROWE, SOL. SHAPPIRO, of counsel For the Plaintiffs

PITNEY, HARDIN & WARD By WILLIAM P. REISS, JAMES A. FOWLER, JR., of counsel For the Defendant

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MEANEY, District Judge.

This is an action brought by Ellis-Foster Company and Montclair Research Corporation against Union Carbide Corporation asking this court to reverse and correct certain alleged errors on the part of the United States Patent Office.

Plaintiffs assert that this court has jurisdiction under 35 U.S.C.A. §146:

> "Any party to an interference dissatisfied with the decision of the board of patent interferences *on the question of priority*, may have remedy by civil action. * * *" (Emphasis added.).

Plaintiffs and defendant, though not the original applicants or patentee, will hereinafter be referred to as such

Two applications in this matter were filed in the Patent Office, each concerned with the reactions of silanes with olefins and one of them, the defendant's, including claims to reactions with alkynes as well as olefins. Plaintiffs' application No. 679,856 was filed on June 27, 1946, and the defendant's No. 702,084 was filed on October 9, 1946.

The defendant, Union Carbide Corporation, on March 17, 1953, was granted Pat. No. 2,632,013 which included Claim No. 2 reading as follows:

> "A process for the production of organosilicon compounds which comprises reacting an alkyne with a silane of the group consisting of halogenosilanes and alkoxysilanes having at least one Si—H bond while heating the reactants at substantially constant volume and at a temperature not substantially above 350°C."

This related to the alkyne reaction with a silane. The applications with reference to the Silane-olefin reactions had been disposed of in favor of two companies other than the parties to the present action after two earlier interferences.

On April 10, 1953, the plaintiffs amended their application to copy into it Claim No. 2 above cited. This was the first inclusion in that application of a claim concerning a reaction with alkynes. On May 18, 1953, the Primary Examiner in the Patent Office declared a new interference proceeding No. 86,436 with the alkyne claim as the count in interference.

Motion was made by the defendant to dissolve the interference proceeding on the ground of insufficient disclosure of the subject matter of Claim No. 2 in plaintiffs' application. The Primary Examiner denied this motion on August 26, 1954.

The matter was then referred to the Board of Patent Interferences which on January 25, 1957, rendered its decision in favor of the defendant, finding that the Primary Examiner had erroneously instituted the interference since the plaintiffs' application did not sufficiently disclose the

subject of the count. Previously there had been testimony on the part of the defendant to show priority of invention by way of experiments successfully completed in February, 1946, though the filing date of its application was October 9, 1946. The plaintiffs seem to have rested content with establishment of the filing date of its application, June 27, 1946.

The whole question now to be adjudged is what actually was the effect of the decision of the Board of Patent Interferences. Upon this depends the jurisdiction of this court. If it was a determination of priority, then the present action will lie. If effectively, in spite of some of the language used in its opinion, the Board dissolved the interference, then this court should not assume jurisdiction, since its jurisdiction is not controlled by the equities of the situation, but by the specific limitations adumbrated or outlined in the patent laws.

In its decision the Board of Patent Interferences said:

> "The question of support for the count in the MSS (plaintiffs here) application was considered by the Primary Examiner and decided favorably to MSS. The Primary Examiner's decision will be considered on review to the extent that there is raised a question ancillary to priority, namely, whether or not the MSS application sufficiently teaches a disclosure upon which the count is readable * * *. It is held therefore that the MSS application does not support the count * * *. Under the circumstances W and S (defendant here) stand to prevail and it is not necessary to discuss the testimony * * *. Priority of invention of the subject matter in issue is hereby awarded to George H. Wagner and Corneille O. Strother, the junior party (defendant here)."

Despite the testimony as to priority given before it, the Board made no mention of any proofs of priority and held that the plaintiffs' application did not support the count in dispute and this is the real gist of their finding. The

language of the last sentence quoted from its decision in nowise refers to an examination of evidence of priority, and is rendered inept since there could be no question of priority if the application did not warrant issuance of a patent.

Had both applications been processed and approved, both of which would entitle applicants to a patent, then the question of priority would arise, and after a finding of priority, the unsuccessful party might then appeal to this court, which under 35 U.S.C.A. §146 would have jurisdiction.

But in the instant case the contest is in reality not between two applicants, but between the applicant whose application has been found to be defective and the Patent Office, proper method of review in such case being by ex parte appeal through the tribunals of the Patent Office and then to the Court of Customs & Patent Appeals, or the United States District Court for the District of Columbia.

Had the Board of Patent Interferences limited its finding to dissolution of the interference as it might have done, there could have been no appeal to this court and the plaintiffs would have been left without equivocation to the remedies above referred to. It is unfortunate that its findings were so inclusive that plaintiffs were uncertain as to the relief available.

Under the circumstances the motion of defendant to dismiss will be granted.

Let an order be submitted.

APPENDIX C.

Opinion of the Court of Appeals for the Third Circuit, Filed November 3, 1960.

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT.

No. 13,187

ELLIS-FOSTER COMPANY AND MONTCLAIR RESEARCH LABORATORIES,

v.

UNION CARBIDE AND CARBON CORPORATION.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

Argued June 10, 1960

Before BIGGS, *Chief Judge*, and KALODNER and FORMAN, *Circuit Judges*

OPINION OF THE COURT

(Filed November 3, 1960)

By BIGGS, *Chief Judge*.

This is an appeal from an order of the court below dismissing an action brought by the plaintiffs pursuant to Section 146 of Title 35 U. S. C. on the ground that jurisdiction of the subject matter was lacking. For purposes of clarity the appellants, Ellis-Foster Company and Montclair Research Laboratories will be designated as the plaintiffs.

and the appellee, Union Carbide and Carbon Corporation, will be called the defendant.[1]

On June 27, 1946, the plaintiffs-appellants, Ellis-Foster Company and Montclair Research Corporation, filed their patent application No. 679,856. On October 9, 1946 the defendant-appellee, Union Carbide and Carbon Corporation, filed its patent application No. 702,084. On March 17, 1953 the defendant's application resulted in the issuance of patent No. 2,632,013. Claim 2 of the patent was as follows: "A process for the production of organo-silicon compounds which comprises reacting an alkyne with a silane of the group consisting of halogenosilanes and alkoxysilanes having at least one Si-H bond while heating the reactants at substantially constant volume and at a temperature not substantially above 350° C."

Thereafter, on April 10, 1953, the plaintiffs amended their application to copy into it Claim 2 as quoted above. On May 18, 1953, the Primary Examiner in the Patent Office declared an interference, No. 86,436, with Claim 2 as the count in interference. The defendant then filed a motion under Rule 232 of the Rules of Practice of the Patent Office to dissolve the interference on several grounds, one being the alleged failure of the plaintiffs' specifications to disclose the subject matter of the count and other

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[1] Ellis-Foster Company and Montclair Research Corporation, the plaintiffs below, are assignees of Charles A. Mackenzie, Leonard Spialter and Milton Schoffman. The defendant is assignee of George H. Wagner and Corneille O. Strother. Although the parties appear variously in the record under the names of their predecessors in interest they will be referred to in this opinion, as plaintiff and defendant, respectively.

These predecessors in title of the parties to the suit at bar are referred to in the interference proceedings in the Patent Office in various ways. In the proceedings before the Primary Examiner, Wagner and Strother, the assignors of the defendant, Union Carbide and Carbon Corporation, are referred to as "Wagner" and in the proceedings before the Board of Patent Interferences as "W and S". In the proceedings before the Primary Examiner, MacKenzie, Spialter and Schoffman are referred to as "MacKenzie" and in the proceedings before the Board of Patent Interferences as "MSS".

grounds being that the plaintiffs were not entitled to assert the claim because of abandonment and estoppel. The plaintiffs moved also to dissolve the interference under Rule 232 but the issues raised by that motion were deferred until final hearing. The Primary Examiner, holding that the plaintiffs' right to assert the claim was not invalidated by abandonment or estoppel and that the plaintiffs' specification sufficiently disclosed Claim 2, quoted above, denied the defendant's motion to dissolve the interference.

The plaintiffs, the senior parties, chose to offer no testimony. The defendant, the junior party, took testimony and introduced exhibits to show that the invention had been conceived about August 1945 and had been reduced to practice during the period from November 1945 to February 1946. The interference proceeding then went to final hearing before the Board of Patent Interferences.

The Board concluded for reasons that need not be stated here that the plaintiffs were not estopped to contend that their specifications taught Claim 2 as quoted above and that the defendant's specifications contained a specific example which read on that count. The Board held also that it was unnecessary to discuss the evidence adduced by the defendant as to priority of invention because the plaintiffs' specifications did not sufficiently teach a disclosure which was readable on Claim 2, contrary to the Primary Examiner's conclusions in this regard; and that therefore the defendant was entitled to prevail. The Board then stated: "Priority of invention of the subject matter in issue is hereby awarded to [the defendant], the junior party."[2] This can be stated in other words as follows: Since the plaintiffs could not make

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[2] This very pertinent portion of the Board's opinion is quoted in the opinion of the court below, 179 F. Supp. at p. 178, as follows: "The question of support for the count in the MSS (plaintiffs here) application was considered by the Primary Examiner and decided favorably to MSS. The Primary Examiner's decision will be considered on review to the extent that there is raised a question ancillary to priority, namely, whether or not the MSS application sufficiently teaches a disclosure upon which the count is readable • • •. Priority of invention of the subject matter in issue is hereby awarded to George H. Wagner and Corneille O. Strother, the junior party (defendant here)."

See also note 1, *supra*.

a valid claim for the invention because their specifications did not disclose it, priority had to be awarded to the defendant, there being no valid claim in the plaintiffs on which any assertion of priority could be bottomed by them.

Here, of course, arises the anomaly presented by the case at bar. The Primary Examiner decides many issues on interference including adequacy of disclosures by specifications in relation to claims estoppels, patentability, and informalities which may preclude the proper determination of question of priority, but he may not make an "award of priority". See Rule 232 of the Rules of Practice of the Patent Office. If the Primary Examiner grants a motion to dissolve the interference on an issue ancillary to priority, as he did not do in the instant case, in effect he decides the issue of priority, for the winning party of necessity has priority over the losing party who retains no status at all. If the Primary Examiner denies all motions, as here, depositions are taken, briefs are filed, and the interference goes to final hearing before the Board of Patent Interferences, as it did here. The Board of Patent Interferences proceeds to decide the question of priority and makes an award of priority as it did here. In determining priority the matters to be considered are set out carefully in Rule 258.[3] But the anomaly arises

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[3] Rule 258 of the Rules of Practice is as follows:

"In determining priority of invention, the Board of Patent Interferences will consider only priority of invention on the evidence submitted. Questions of patentability of a claim generally will not be considered in the decision on priority; and neither will the patentability of a claim to an opponent be considered, unless the nonpatentability of the claim to the opponent will necessarily result in the conclusion that the party raising the question is in fact the prior inventor on the evidence before the Office, or relates to matters which have been determined to be ancillary to priority and must be considered, but a party shall not be entitled to raise such non-patentability unless he has duly presented and prosecuted a motion under rule 232 for dissolution upon such ground or shows good reason why such a motion was not presented and prosecuted.

"The matters raised on a motion relating to the burden of proof (rule 235) may be reviewed at final hearing.

"At final hearing between an application and a patent the prior art of record in the patent file may be referred to for the purpose of construing the issue."

from the fact that the Board of Patent Interferences, while determining priority, in fact may determine and frequently does determine the right of the parties to the interference to make the claim by determining, as happened here, that the specification of one party did not sufficiently disclose the claim. In short the Board of Patent Interferences decided in the case at bar as it frequently does in cases presenting analogous circumstances, that priority should be awarded to the junior claimant, the defendant, because the senior party, the plaintiffs, could not validly assert the claim. Thus, the Board made an award of priority on the basis of its resolution of the question of the plaintiffs' right to make the claim. That decision, had it been made by the Primary Examiner in the first instance, would have resulted in an unreviewable order dissolving the interference.

On the basis of the opinion of the Board the court below found that ". . . effectively, in spite of some of the language used in its opinion, the Board dissolved the interference." The court also said that "[T]he language of the last sentence quoted from its decision nowise refers to an examination of evidence of priority, and is rendered inept since there could be no question of a patent." 179 F. Supp. 177, 178. It is the nature of the Board's decision that presents the prime issue in this case. The jurisdiction of a United States district court under Section 146, Title 35, U.S.C., is limited to actions brought by "[A]ny party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority. . . ." Whether the decision of the Board in the present case was a decision "on the question of priority" within the purview of the patent law is the question that we must decide.

The defendant makes two arguments in support of the decision of the court below. First, it contends that Section 146, Title 35, U.S.C. does not confer jurisdiction on a United States District Court to consider a decision of the Board of Patent Interferences on a question ancillary to priority which, had it been decided correctly by

the Primary Examiner when presented on a motion to dissolve, necessarily would have resulted in a dissolution of the interference. In support of this proposition the defendant insists that the remedy under Section 146 must be limited to a consideration of decisions "on the question of priority" and argues that a decision on a question such as that framed by the circumstances of this case is, in reality, a finding that no interference existed at all and is not a decision on the question of priority. The defendant asserts further that under Section 146 the Commissioner of Patents is not a necessary party and contends that for this reason the question of a right to make the count, involving a "public interest", may be considered only in an *ex parte* proceeding where the Commissioner is necessarily a party.

The defendant's second argument is that even if a remedy under Section 146 is available where the Primary Examiner erroneously denied a motion to dissolve and a judgment of priority is entered by the Board of Patent Interferences, that remedy should not be available in the case at bar, since the Board's decision was, in substance, an order granting the defendant's motion to dissolve and such an order is not reviewable under the statute. This latter argument was accepted by the court below.

We think that both the defendant's contentions are without merit. First, we will endeavor to show that under the law in effect prior to the enactment of Section 146 in 1952, the courts had jurisdiction to grant a remedy where the decision at final hearing turned on a point which, if decided correctly by the Primary Examiner, would have resulted in a dissolution of the interference. We shall then try to demonstrate that none of the 1952 amendments to the prior law, codified 66 Stat. 792, 35 U.S.C. §1, *et seq.*, required a change in this procedure. Finally, we will distinguish the decision of the Board in the present case from a decision which is in effect an order granting a motion to dissolve, thus demonstrating that the decision of the Board in the instant case is reviewable.

The first issue to be determined is whether, under the prior law,[4] a decision rendered on a question ancillary to priority, which would have resulted in dissolution of an interference had the Primary Examiner entered the decision on a motion to dissolve, was a basis for a review in the courts. The defendant not only concedes but affirmatively contends that the question decided by the Board in the present case is one that is ancillary to priority. That a question of the right to make the count in interference, such as is here involved, is a question that is ancillary to priority was decided in Podlesak *v.* McInner-

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[4] 16 Stat. 205 (1870), as amended 44 Stat. 1336 (1927), as amended 45 Stat. 1476 (1929), as amended 53 Stat. 1212 (1939), 35 U.S.C. §63 (1946 ed.) provided:

> "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

ney, 26 App. D. C. 399 (1906). See the full discussion of ancillary questions in Snelling *v.* Brooks, 47 App. D. C. 428 (1919). The significance of a question being designated as "ancillary" is that it may be considered by a tribunal whose jurisdiction is limited to determination of the question of priority. Before the *Podlesak* decision the question of the right to make the count was remanded, pursuant to what is now Rule 259, to the Primary Examiner as a basis for a possible dissolution of the interference. See Judd *v.* Campbell, 1903 C.D. 502, 107 O.G. 2527. It is now settled that only non-ancillary questions are remanded under Rule 259. The reason for changing the practice has been stated as follows: "The question of the right of a party to make a claim goes to the very foundation of an interference, for, if a party has not such right, the interference falls. If it be incorrectly held that such party has a right to make the claim, priority may be awarded to him, and his adversary be deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. Manifestly that question should not be finally determined by the primary examiner who originally declared the interference. We therefore take the jurisdiction to determine that question in this case as an ancillary question to be considered in awarding priority of invention." Podlesak *v.* McInnerney, *supra*, 26 App. D. C. at p. 405.

This reasoning was carried to a logical conclusion, and the practice based on it is fully outlined in Brown *v.* Hodgkinson, 1906 C.D. 290, 123 O.G. 2973. In the cited case Brown moved, before the Examiner of Interferences,[5] that the interference be remanded to the Primary Examiner for further consideration of the right of Hodgkinson to make the claim in issue. The Examiner of Interferences agreed

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[5] The Examiner of Interferences then occupied a position in the hierarchy of the Patent Office substantially similar to that subsequently filled by the Board of Patent Interferences.

with Brown and pursuant to what is now Rule 259,[6] called the issue of Hodgkinson's right to make the claim to the Commissioner's attention. The Commissioner then remanded the case to the Primary Examiner for further consideration. Brown, believing that he was entitled to an award of priority based on the conclusion of the Examiner of Interferences, brought a motion to secure such action. In an instructive opinion the Commissioner stated:

> "In certain cases, like the present case, the decision upon matters to which attention is called under . . . [Rule 259] . . . has an effect similar to a determination which of the parties is the prior inventor. The question is whether it would not be an improvement upon the present practice if the Examiner of Interferences in these cases would make his opinion the basis of a judgment upon priority of invention instead of calling attention to the supposed facts under . . . [Rule 259] . . . I am of the opinion that it would be an improvement, for the following reasons: As was pointed out by the court of appeals in Podlesak and Podlesak *v.* McInnerney, (*post*, 558; 120 O.G. 2127,) a decision holding erroneously that one party has a right to make claims, if not set aside, will, under certain conditions similar to the supposed

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[6] Rule 259 of Rules of Practice of the United States Patent Office in Patent Cases, September 1955, is as follows:

> "The Board of Patent Interferences may, either before or concurrently with their decision on the question of priority, but independently of such decision, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which in their opinion establishes the fact that no interference exists, or that there has been irregularity in declaring the same, or which amounts to a bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed if such matters have not been considered before by the examiner, or take other appropriate action. If the case is not so remanded, the primary examiner will, after judgment on priority, consider such matters, unless the same shall have been previously disposed of by the Commissioner."

conditions of the present case, result in the grant of a patent to one who is not the first inventor and in the loss of a patent by one who, as between the parties, is the first and only inventor of the matter in issue. The court said, further, in the same decision that such a question should manifestly not be finally determined by the Primary Examiner who declared the interference. To refer such a question to the Primary Examiner under . . . [Rule 259] . . . is exactly, therefore, what is discountenanced by the court, for under long-established practice, sound in principle as a general proposition, the affirmative decision of the Primary Examiner upon matters of merits thus referred to him is final. If matters are made the basis of a judgment of priority of invention instead of being referred to the Primary Examiner, the defeated party will have the right of appeal, and this will be true though the decision involves an affirmation of the successful party's right to make claims. Clearly a party whose right to a patent is denied by an affirmance of another's right to make claims should be permitted to contest the decision against him through the full course of appeal, and I see no more direct and desirable mode of securing this result than by making the decision one upon priority of invention.

"There is another reason why the right of a party to make claims, where an affirmance will determine adversely the right of another party to a patent, should be considered at final hearing as a question of priority of invention instead of upon reference under . . . [Rule 259] . . . as a question of dissolution. In the former case the course of appeal is direct through the various tribunals of this Office to the court of appeals if that court will entertain that question when so presented. I am led to believe that the question will be so entertained from the decisions in the cases of Allen, Commissioner of Patents *v.* The United States of America, *ex rel.* Lowry and Planters Compress Company, (C.D., 1905, 643; 116 O.G. 2253,) and

Podlesak and Podlesak *v.* McInnerney, (*post*, 558; 120 O.G. 2127). When the question is treated under . . . [Rule 259] . . . a holding that there is no right to make claims is appealable through the various tribunals of this Office, and if not disturbed thereupon the interference is dissolved, since the court of appeals will not entertain an appeal upon the reference. The party whose right to claim is denied may return to the Primary Examiner and institute another course of appeal through this Office in order that he may have his appeal to the court. After all the court may reverse the conclusion of the Office, and the other interferant may in the meantime have obtained his patent. There seems to be no room for question which of these courses is the better.

"It is ordered that the jurisdiction of the Primary Examiner be withdrawn and that the case be remanded to the Examiner of Interferences, who is authorized to render judgment of priority of invention according to his convictions in view of such evidence as is properly before him, including the applications and patents of the parties. The Examiner of Interferences will not consider questions regarding Hodgkinson's right to his reissue patent which do not affect the determination of priority of invention. Consideration of these questions is reserved until the question of priority has been fully finally determined, unless otherwise hereafter directed."

As in the case at bar the question in the foregoing cases was what procedure would be most desirable when it is decided at final hearing that one party has no right to make the count. The suggestion that the case be remanded to the Primary Examiner under Rule 200 for further consideration was rejected. Nor did the Commissioner approve the very similar procedure sought by the defendant in the present case; *viz.*, that the interference be terminated at final hearing thus leaving the losing party to whatever

remedies he might obtain by commencing *ex parte* proceedings. On the contrary it was decided by the Commissioner that the better procedure was to consider a decision on the right to make the count as a decision on the question of priority thus clearing the way for the full course of review and a final disposition of the matter. In accord with the foregoing, the reports are replete with cases in which review was had of awards of priority bottomed on a decision that one party had no right to make the count. See, *e.g.*, Minnesota Mining & Mfg. Co. *v.* Carborundum Co., 155 F. 2d 746, 749 (3 Cir., 1946); Smith *v.* Carter Carburetor Corp., 130 F. 2d 555 (3 Cir. 1942); Kirschbraun *v.* Doherty, 90 F. 2d 251 (C.C.P.A. 1937). We conclude, therefore, that under the practice established prior to the codification and revision of 1952, a decision rendered on a question ancillary to priority, a decision which would have resulted in dissolution of the interference had the Primary Examiner not erred when presented with a motion to dissolve, was subject to remedy or to review in the courts.

It remains to consider whether the 1952 codification and revision of the Patent Laws changed this practice. The defendant points to the fact that while old Section 63 granted a remedy to "any applicant dissatisfied with the decision of the Board of Interference examiners", Section 146 grants a remedy to "[A]ny party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority." It is argued that where, as here, the interference should have been dissolved initially, a decision of the Board made possible only by that error should not be considered "on the question of priority". In this connection it should be pointed out that under present Patent Office practice the question of a right to make a count, even when raised on a motion to dissolve is often deferred until final hearing and there made the basis of a judgment of priority. It is, therefore, not as anomalous as it may first appear to have that question determined in the negative at final hearing as here. It must be realized also that the courts under the prior law were likewise limited

in their review of Patent Office Proceedings to decisions "on the question of priority". See United States *ex rel.* Lowry *v.* Allen, 203 U.S. 476, 1906 C.D. 765, and 2 Walker On Patents, (Deller's ed. 1937) p. 944 *et seq.* The courts are similarly limited in review under Section 146 of the present law. The defendant is here seeking a substantial change in a practice of long standing basing its contention on a change in language which is very nearly neutral. It does not challenge the reasoning of the Commissioner in the *Brown* and *Podlesak* decisions, *supra*, which argue strongly for an unobstructed review of issues such as those presented at bar. The defendant does, however, make the argument that since there is a "public interest" in a correct determination of the question of whether a claim can be made, the Commissioner of Patents, under a correct application of the law should be an indispensable party to any proceeding determining that issue.

We have said that the language changes in Section 146 over old Section 63 are very nearly neutral. The most important one, relative to the issues at bar lies in the addition of the fourth sentence of the second paragraph to Section 146. This provides: "The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene". The legislative history of the sentence quoted is very brief. S. Rep. No. 1979, U. S. Code Cong. & Ad. News, 82nd Cong. 2d Sess., p. 2416 (1952), states: "The fourth sentence is new and prevents suits from being filed against the Commissioner as a defendant; however, the Commissioner has the right to intervene." The practice, as we have demonstrated, was well established and we think the conclusion is a very supportable one that had Congress intended to change it, it would have indicated that desire in unmistakable language both in the new statute itself and in its accompanying legislative history. The Commisioner is given the right to intervene and he will do so we assume, if in his judgment, the public interest requires that course. Once he has intervened his oppor-

tunity to protect the public is as complete as if he were an indispensable party. Section 146 in effect codifies what may be described as a streamlining procedure whereby the parties to an interference may have a prompt final determination at a stage when all testimony and argument relative to the issue of priority have been presented. Such a result seems eminently desirable. If on the other hand, were we to follow the procedure sought by the defendant the interference would be declared to be dissolved, and Section 146 would be inapplicable, forcing the losing party to press his claim through the whole of the complex Patent Office procedures, probably finally requiring him to bring an infringement suit or an action under Section 291, Title 35, U.S.C., to determine the very issue determinable at an early stage under Section 146. The preferable course of an early determination of the vital issue of priority has been approved by the Court of Patent Appeals in Vandenberg *v.* Reynolds, 242 F. 2d 761 (C.C.P.A. 1957),[7] albeit in a proceeding relating to Rule 56, "Improper application", but the analogy is persuasive.

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[7] In Vandenberg *v.* Reynolds, 242 F. 2d 761 (C.C.P.A. 1957), the court reversed the Commissioner's determination that in an interference proceeding the question whether a party's application was improperly altered after it was executed should not be passed upon during the interference but should be considered *ex parte* upon final determination of priority. The court held that the question presented was ancillary to priority. In answer to the contention that "[S]ince the striking of an application from the files is punitive in nature, if such penalty is exacted, it should be to the benefit of the public through an ex parte proceeding . . . .", the court said in part: "In the interest of orderly procedure and the conservation of judicial man hours, both here and in the Patent Office, it seems to us that any issue which may be determinative of the continuance or outcome of an interference should be decided by the tribunal having jurisdiction thereof when it is first properly raised and not postponed until after the consideration of the usually complex factual issues involved in the merits of priority disputes. In this case the issue which was left undecided and deferred by the Assistant Commissioner has been elaborately briefed and argued, along with the strictly priority questions, both here and before the board, all to no avail for want of an initial decision."

In view of the foregoing we hold that an award of priority by the Board of Patent Interferences based on the resolution of a question that is ancillary to priority, which decision had it been made correctly by the Primary Examiner in the first instance would have resulted in the dissolution of the interference, is a decision "on the question of priority" within the meaning of Section 146.

This brings us to the defendant's second contention, which is that even granting our conclusion above, the decision of the Board in the present case is not one "on the question of priority" since it was, in effect, an order granting a motion to dissolve which is an unreviewable order. As established above a decision by the Board on an ancillary question, such as this one, may form the basis of an award of priority which may in turn be the basis for a court administered remedy. But, it is equally clear that not all decisions on ancillary questions are reviewable. It has long been settled that an order by the Primary Examiner sustaining a motion to dissolve even though on grounds ancillary to priority, is interlocutory in nature and may not be reviewed. See, *e.g.*, Cosper *v.* Gold, 34 App. D. C. 194 (1910); American Cable Co. *v.* John A. Roebling's Sons Co., 65 F. 2d 801 (D. C. Cir. 1933). It follows, as was noted by the court below, that if the decision of the Board of Patent Interferences was in substance the granting of a motion to dissolve, this action will not lie merely because the Board labels its decision one "on the question of priority". Carlin *v.* Goldberg, 45 App. D. C. 540 (1917). Cf. In re Zalkind, 126 F. 2d 835, *rehearing denied*, 128 F. 2d 264 (C.C.P.A. 1942).

We point out that in the case at bar the Board did not dissolve the interference. The Board did award priority. Compare the operative facts at bar with those of Carlin *v.* Goldberg, *supra*, heavily relied on by the defendant. In that case Goldberg moved to dissolve the interference on the ground that Carlin had no right to make the count. This motion was granted by the Primary Examiner thus precluding either party from taking testi-

mony. Carlin then succeeded in having the Commissioner change the order of dissolution to a judgment of priority so that he could obtain review. The Court of Appeals held that it had no jurisdiction to review the "judgment of priority" explaining its decision as follows: "Let us consider for a moment where the appeal, if we were to take jurisdiction, would logically lead. If we should review the Commissioner on the question of priority, the only decision from which an appeal will lie to this court in an interference proceeding, it would operate as a grant of priority to Carlin, the junior party, without giving Goldberg, the senior party, his day in court on that issue." 45 App. D. C. at p. 544. The lack of application of the Goldberg decision to the case at bar is apparent. In the Goldberg case, unlike the case at bar, no testimony was taken and there was no final hearing before the Board.

The defendant's contention that the decision of the Board was in effect an order granting a motion to dissolve ignores the critical distinction between such an order and a decision of the Board based on an ancillary question after the motion to dissolve has in fact been denied by the Primary Examiner. When the Primary Examiner grants a motion to dissolve the interference, no testimony has as yet been taken or briefs submitted on the question of priority. If, however, such a motion is denied by the Primary Examiner, albeit incorrectly, testimony is taken and briefs are submitted for the final hearing before the Board. Thereafter, when the Board awards priority by resolving a question ancillary to priority, the resources of the Patent Office and of the parties have been committed to its resolution, thus justifying and permitting a final determination of the controversy by direct judicial review. This is the critical distinction between the granting of a motion to dissolve by the Primary Examiner and an award of priority by the Board by the resolution of a question ancillary to priority. If, therefore, in the present case testimony was taken and the case was considered fully on the merits, the decision must be deemed to have been "on the question of priority." In the case at bar after the

defendant's motion to dissolve was denied by the Primary Examiner, a full opportunity to take testimony was given to both parties as we have pointed out. Only the defendant elected to do so. The plaintiffs presumably planned to rely on other grounds at final hearing before the Board. After final hearing, the case having been fully briefed and argued, the Board rendered its decision. An examination of the Board's opinion shows that it decided first, that under no possible contingency would it be required to consider the defendant's testimony. This was so because if the plaintiffs had no right to make the count, testimony as to conception and reduction to practice was immaterial for the defendant would be entitled to a judgment of priority. If, on the other hand, the plaintiffs did have a right to make the count, the defendant would be estopped and the plaintiffs would be entitled to a judgment of priority. The Board then went on to consider what it deemed to be the critical question in the case; *viz.*, whether the plaintiffs had a right to make the count in interference. It considered the question, and properly, as a question ancillary to priority. Finally, the Board found that the plaintiffs' application did not support the count and, therefore, awarded priority to the defendant. It thus appears that the Board gave the case full consideration on the merits. True, it did not consider the defendant's testimony, but this was due not to the fact that it was granting a motion to dissolve but because the fullest consideration of the question of priority did not demand an examination of that testimony. It follows that the Board of Patent Interferences rendered a decision "on the question of priority." In short the Board did precisely what it said it did. The District Court, therefore, had jurisdiction of the subject matter pursuant to Section 146, Title 35, U.S.C.[*]

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[*] The United States District Court for the Eastern District of Pennsylvania in the case of Radio Corporation of America v. Philco Corporation, ... F. Supp. ... (E.D. Pa. 1960), reached a like decision on substantially similar facts albeit on somewhat different reasoning. See also Turchan v. Bailey Meter Co., 167 F. Supp. 58 (D. Del. 1958).

The judgment will be reversed and the case remanded for determination of priority as required by Section 146, Title 35, U.S.C.

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JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960

No. 587

UNION CARBIDE AND CARBON CORPORATION,
Petitioner,

against

ELLIS-FOSTER COMPANY and MONTCLAIR RESEARCH CORPORATION,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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January 16, 1961

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Reasons for Denying the Writ

I

THE QUESTION OF PRIORITY WAS SQUARELY DECIDED BY THE BOARD OF PATENT INTERFERENCES.

The question here is simply as to the *nature* of the decision of the Board of Patent Interferences. If the Board's decision is a decision on the question of priority of invention, then the District Court has jurisdiction of respondents' complaint which seeks to review the Board's decision by civil action under 35 U.S.C. §146.

Thus, the issue in this case involves but a single question: Did or did not the Board of Patent Interferences render a decision on the question of priority of invention as between petitioner and respondents?

The Board's decision itself explicitly awards priority of invention in its concluding paragraph:

> "Priority of invention of the subject matter in issue is hereby awarded to George W. Wagner and Corneille O. Strother, the junior party," [Petitioner's assignors]
>
> Decision at final hearing of Board of Patent Interferences dated January 25, 1957, at Page A-8 of the Appendix to the Petition herein.

Respondents filed their complaint in the present action in the District Court for the District of New Jersey to review this award of priority and alleged:

> "1. The jurisdiction of this Court depends upon the statutes of the United States relating to the grant and issuance of Letters Patent of the United States and particularly upon that section thereof known as Title 35, United States Code, Section 146, no appeal having been taken to the United States Court of Customs and Patent Appeals.
>
> • • •
>
> 35. Plaintiffs therefore are the prior inventors of the invention in issue, and the decision of said Board awarding priority of the invention in issue to defendant was erroneous."

Petitioner answered by alleging:

> "1. Defendant admits the averments of paragraph 1 of the complaint.
>
> • • •
>
> 35. Defendant denies the averments in paragraph 35."

Petitioner then moved to dismiss respondents' complaint on the ground that the Board's decision was not a decision on the question of priority of invention but was in effect the granting of a motion to dissolve the interference previously made before the Primary Examiner but denied by him. The District Court granted petitioner's motion but the Court of Appeals for the Third Circuit reversed, saying:

> "In the case at bar after the defendant's motion to dissolve was denied by the Primary Examiner, a full opportunity to take testimony was given to both parties as we have pointed out it. Only the defendant elected to do so. The plaintiffs presumably planned to rely on other grounds at final hearing before the Board. After final hearing, the case having been fully briefed and argued, the Board rendered its decision. An examination of the Board's opinion shows that it decided first, that under no possible contingency would it be required to consider the defendant's testimony. This was so because if the plaintiffs had no right to make the count, testimony as to conception and reduction to practice was immaterial for the defendant would be entitled to a judgment of priority. If, on the other hand, the plaintiffs did have a right to make the count, the defendant would be estopped and the plaintiffs would be entitled to a judgment of priority. The Board then went on to consider what it deemed to be the critical question in the case; *viz.*, whether the plaintiffs had a right to make the count in interference. It considered the question, and properly, as a question ancillary to priority. Finally, the Board found that the plaintiff's application did not support the count and, therefore, awarded priority to the defendant. It thus appears that the Board gave the case full consideration on the merits. True, it did not consider the defendant's testimony, but this was due not to the fact that it was granting a motion to dissolve but because

> the fullest consideration of the question of priority did not demand an examination of that testimony. It follows that the Board of Patent Interferences rendered a decision "on the question of priority." In short the Board did precisely what it said it did. The District Court, therefore, had jurisdiction of the subject matter pursuant to Section 146, Title 35, U.S.C.[8]" Page C-16, last line, and page C-17 of the Appendix to the Petition herein.

Petitioner's prayer for a writ is based on the assertion that the Board of Patent Interferences did not do what it said it did. The Board's award of priority and the Court of Appeals' reading of the Board's decision make it manifestly clear that petitioner's interpretation of the Board's decision is erroneous. We submit, therefore, that the rejection by the Court of Appeals of petitioner's interpretation of the Board's decision does not present a question warranting review by this Court.

II

THE COURT OF APPEALS HELD THAT THE BOARD'S AWARD OF PRIORITY WAS IN STRICT ACCORDANCE WITH ESTABLISHED PRACTICE.

The decision of the Court of Appeals decision is in full accord with established patent practice. As stated by the Court of Appeals (page C-12 of the Appendix to the Petition):

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[8] The United States District Court for the Eastern District of Pennsylvania in the case of Radio Corporation of America v. Philco Corporation, 187 F. Supp. 940 (E.D. Pa. 1960), reached a like decision on substantially similar facts albeit on somewhat different reasoning. See also Turchan v. Bailey Meter Co., 167 F. Supp. 58 (D. Del. 1958).

> "In accord with the foregoing, the reports are replete with cases in which review was had of awards of priority bottomed on a decision that one party had no right to make the count. See, *e.g.*, Minnesota Mining & Mfg. Co. *v.* Carborundum Co., 155 F. 2d 746, 749 (3 Cir., 1946); Smith *v.* Carter-Carburetor Corp., 130 F. 2d 555 (3 Cir. 1942); Kirschbraun *v.* Doherty, 90 F. 2d 251 (C.C.P.A. 1937). We conclude, therefore, that under the practice established prior to the codification and revision of 1952, a decision rendered on a question ancillary to priority, a decision which would have resulted in dissolution of the interference had the Primary Examiner not erred when presented with a motion to dissolve, was subject to remedy or to review in the courts."

On the other hand, the interpretation placed by petitioner on the Board's decision would in fact upset established patent practice in interference matters. See in this connection *Radio Corporation of America* v. *Philco Corporation*, 187 F. Supp. 940, 944 (E. D. Pa. 1960), referred to in footnote 8 of the Court of Appeals' opinion, *supra*, p. 4. In that case the District Court in Pennsylvania rejected the New Jersey District Court's acceptance of petitioner's arguments in this case and said:

> "Ellis-Foster, supra, places patent litigants in a precarious position. After the Board of Patent Interferences has rendered an Ellis-Foster adjudication, parties must, at best, literally guess where they may proceed next."
>
> *Radio Corp. of America* v. *Philco Corp.*, 187 F. Supp. 940, 944.

The above decision was handed down on October 17, 1960. On November 3, 1960 it was followed by the decision of the Court of Appeals for the Third Circuit in the case

at bar which, by reversing the District Court (N. J.), removed the uncertainty created by that decision and re-established the practice prevailing prior to the District Court's decision in this case.

Petitioner incorrectly asserts:

> "In our case respondents are claiming that they are entitled to take something out of the public domain and to have the Commissioner issue a patent giving them the exclusive right to it for the next 17 years."
>
> Petition herein, page 10

This is not respondents' claim. Respondents' claim is that they are entitled to a patent covering the invention set forth in Claim 2 of petitioner's Patent No. 2,632,013 because respondents are the prior inventors of that invention. This subject matter is obviously not in the public domain since it is already the subject of the patent owned by petitioner. The dispute between petitioner and respondents is as to the question of priority of invention in relation to that subject matter and not as to whether that subject matter is in the public domain.

III

SINCE THIS IS AN ACTION UNDER 35 U.S.C. §146 THE COMMISSIONER OF PATENTS IS NOT A NECESSARY PARTY.

The statute under which this action is brought provides that the Commissioner of Patents "shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene." 35 U.S.C. §146. Petitioner's argument regarding the necessity of the Commissioner

of Patents being a party confuses §145 and §146 of 35 U.S.C. The instant action is brought solely under 35 U.S.C §146 and hence the Commissioner is not a necessary party.

CONCLUSION

In view of the foregoing, we submit that the District Court has jurisdiction to determine the issue of priority herein under 35 U.S.C. 146 and the petition for a writ of certiorari should be denied.

Respectfully submitted,

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January 16, 1961